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Exhibit C



Federal Register

**Tuesday,
September 21, 2004**

Part II

Department of Commerce

Patent and Trademark Office

**37 CFR Parts 1, 5, 10, 41, and 104
Changes To Support Implementation of
the United States Patent and Trademark
Office 21st Century Strategic Plan; Final
Rule**

56482 Federal Register/Vol. 69, No. 182/Tuesday, September 21, 2004/Rules and Regulations**DEPARTMENT OF COMMERCE****Patent and Trademark Office****37 CFR Parts 1, 5, 10, 41, and 104****[Docket No.: 2003-P-020]****RIN 0651-AB64****Changes To Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan****AGENCY:** United States Patent and Trademark Office, Commerce.**ACTION:** Final rule.

SUMMARY: The United States Patent and Trademark Office (Office) has established a 21st Century Strategic Plan to transform the Office into a quality-focused, highly productive, responsive organization supporting a market-driven intellectual property system. The noteworthy changes in this final rule are: Providing for an alternative signature on a number of submissions; adjusting the fees for a number of patent-related petitions to reflect the actual cost of processing these petitions; codifying the current incorporation by reference practice and also providing the conditions under which a claim for priority or benefit of a prior-filed application would be considered an incorporation by reference of the prior-filed application; expanding the submissions that can be filed on a compact disc; eliminating the requirement for copies of U.S. patents or U.S. patent application publications cited in an information disclosure statement for all applications; providing that a request for information may contain interrogatories or requests for stipulations seeking technical factual information actually known by the applicant; providing that supplemental replies will no longer be entered as a matter of right; providing for the treatment of preliminary amendments present as of the filing date of an application as part of the original disclosure; and eliminating the requirement in a reissue application for the actual physical surrender by applicant of the original Letters Patent.

DATES: Effective October 21, 2004, except that: The changes to 37 CFR 1.4, 1.6, 1.10, 1.27, 1.57(a), 1.78, 1.84, 1.115, 1.137, 1.178, and 1.311, and new 37 CFR 1.57(a)(1) and (a)(2) are effective September 21, 2004; and the changes to 37 CFR 1.12, 1.14, 1.17, 1.19, 1.47, 1.53, 1.57(a)(3), 1.59, 1.84(a)(2), 1.103, 1.136, 1.182, 1.183, 1.291, 1.295, 1.296, 1.377, 1.378, 1.550, 1.741, 1.956, 5.12, 5.15,

5.25, and 41.20 are effective November 22, 2004.

FOR FURTHER INFORMATION CONTACT:

Hiram H. Bernstein, Senior Legal Advisor, by telephone at (703) 305-8713 or Robert J. Spar, Director, Office of Patent Legal Administration (OPLA), at (703) 308-5107, or by facsimile to (703) 305-1013, marked to the attention of Mr. Bernstein, or by mail addressed to: Mail Stop Comments—Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

SUPPLEMENTARY INFORMATION: The Office has conducted a "top to bottom" review of the patent application and examination process (among other processes) as part of the 21st Century Strategic Plan. The 21st Century Strategic Plan is available on the Office's Internet Web site (www.uspto.gov). While many of the changes to the patent application and examination process necessary to support the 21st Century Strategic Plan require enabling legislation (and implementing rule changes), the Office has determined that a number of initiatives can be implemented under the Office's current rulemaking and patent examination authority set forth in 35 U.S.C. 2(b)(2), 131, and 132. This final rule revises the rules of practice in title 37 of the Code of Federal Regulations (CFR) to improve the patent application and examination process by promoting quality enhancement, reducing patent pendency, and using information technology to simplify the patent application process.

This final rule specifically makes changes to the following sections of title 37 CFR: 1.4, 1.6, 1.8, 1.10, 1.12, 1.14, 1.17, 1.19, 1.27, 1.47, 1.52, 1.53, 1.57, 1.58, 1.59, 1.63, 1.69, 1.76, 1.78, 1.83, 1.84, 1.85, 1.91, 1.94, 1.98, 1.102, 1.103, 1.105, 1.111, 1.115, 1.121, 1.131, 1.136, 1.137, 1.165, 1.173, 1.175, 1.178, 1.179, 1.182, 1.183, 1.215, 1.291, 1.295, 1.296, 1.311, 1.324, 1.377, 1.378, 1.550, 1.741, 1.956, 5.12, 5.15, 5.25, 10.18, 41.20, and 104.3. This final rule also amends title 37 CFR by adding new § 1.57 and removing § 1.179. The Office is not proceeding with the proposed changes to §§ 1.55, 1.116, 1.138, 1.502, 1.530, 1.570, 1.902, 1.953, 1.957, 1.958, 1.979, and 1.997 in this final rule. In addition, the Office adopted proposed changes §§ 1.704 and 1.705 in a separate rule making. See *Revision of Patent Term Extension and Patent Term Adjustment Provisions*, 69 FR 21704 (Apr. 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 19, 2004) (final rule).

The following legal advisors and staff of the Office of Patent Legal

Administration may be contacted directly for the matters indicated:

Hiram Bernstein (703) 305-8713:

§ 1.136 and 1.324,

Joni Chang (703) 308-3858: §§ 1.8,

1.10, 1.91, 1.94, 1.98 and 1.111.

Jeanne Clark (703) 306-5603: §§ 1.55 and 1.98.

Terry Dey (703) 308-1201: § 1.178.

Elizabeth Dougherty (703) 306-3156: § 1.121.

James Engel (703) 308-5106: §§ 1.12,

1.14, 1.17, 1.53, 1.59, 1.102, 1.103,

1.131, 1.182, 1.183, 1.291, 1.295, 1.296,

1.377, 1.378, 1.741, 5.12, 5.15, 5.25,

41.20, 104.3.

Karin Ferriter (703) 306-3159: §§ 1.6, 1.19, 1.47, 1.52 (other than (e)(1)(iii) and (e)(3)), 1.58(a) and (c) (other than landscape), 1.63, 1.69, 1.83, 1.84, 1.85, and 1.165.

Anton Fetting (703) 305-8449:

§§ 1.17, 1.53, 1.59, 1.103, 1.105, 1.182,

1.183, 1.295, 1.296, 1.377, 1.378, 1.741,

5.12, 5.15, 5.25, 41.20, 104.3.

Kery Fries (703) 308-0687: §§ 1.76,

1.704, and 1.705.

Eugenia Jones (703) 306-5586: §§ 1.8,

1.10, 1.27, 1.55, 1.57(a), 1.78, 1.91, and

1.94.

Michael Lewis (703) 306-5585: §§ 1.4,

1.19, 1.52(e)(1)(iii) and (e)(3), 1.57(b)-

(f), 1.58(b) and (c) (landscape), and

10.18.

Cynthia Nessler (703) 305-0271:

§ 1.311.

Mark Polutta (703) 308-8122:

§§ 1.213, and 1.215.

Kenneth Schor (703) 308-6710:

§§ 1.137, 1.173, 1.175, 1.179, 1.550, and

1.956.

Fred Silverberg (703) 305-8986:

§ 1.115.

The Office published a proposed rule proposing changes to the rules of practice to improve the patent application and examination process by promoting quality enhancement, reducing patent pendency, and using information technology to simplify the patent application process. See *Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan*, 68 FR 53616 (Sept. 12, 2003), 1275 Off. Gaz. Pat. Office 23 (Oct. 7, 2003) (proposed rule). The Office received thirty written comments (from intellectual property organizations, law firms, businesses, and patent practitioners) in response to this notice of proposed rule making. The comments and the Office's responses to those comments are included in the discussion of the specific rule to which the comment relates. Comments generally in support of a change are not discussed.

Interchange (ASCII). CD-R discs must be finalized so that they are closed to further writing to the CD-R.

(ii) Each compact disc must be enclosed in a hard compact disc case within an unsealed padded and protective mailing envelope and accompanied by a transmittal letter on paper in accordance with paragraph (a) of this section. The transmittal letter must list for each compact disc the machine format (e.g., IBM-PC, Macintosh), the operating system compatibility (e.g., MS-DOS, MS-Windows, Macintosh, Unix), a list of files contained on the compact disc including their names, sizes in bytes, and dates of creation, plus any other special information that is necessary to identify, maintain, and interpret (e.g., tables in landscape orientation should be identified as landscape orientation or be identified when inquired about) the information on the compact disc. Compact discs submitted to the Office will not be returned to the applicant.

■ 13. Section 1.53 is amended by revising paragraph (e)(2) to read as follows:

§ 1.53 Application number, filing date, and completion of application.

(e) * * *

(2) Any request for review of a notification pursuant to paragraph (e)(1) of this section, or a notification that the original application papers lack a portion of the specification or drawing(s), must be by way of a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(f). In the absence of a timely (§ 1.181(f)) petition pursuant to this paragraph, the filing date of an application in which the applicant was notified of a filing error pursuant to paragraph (e)(1) of this section will be the date the filing error is corrected.

■ 14. Section 1.57 is added to read as follows:

§ 1.57 Incorporation by reference.

(a) Subject to the conditions and requirements of this paragraph, if all or a portion of the specification or drawing(s) is inadvertently omitted from an application, but the application contains a claim under § 1.53 for priority of a prior-filed foreign application, or a claim under § 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application, that was present on the filing date of the application, and the inadvertently omitted portion of the specification or drawing(s) is

completely contained in the prior-filed application, the claim under § 1.55 or § 1.78 shall also be considered an incorporation by reference of the prior-filed application as to the inadvertently omitted portion of the specification or drawing(s).

(1) The application must be amended to include the inadvertently omitted portion of the specification or drawing(s) within any time period set by the Office, but in no case later than the close of prosecution as defined by § 1.114(b), or abandonment of the application, whichever occurs earlier. The applicant is also required to:

(i) Supply a copy of the prior-filed application, except where the prior-filed application is an application filed under 35 U.S.C. 111;

(ii) Supply an English language translation of any prior-filed application that is in a language other than English; and

(iii) Identify where the inadvertently omitted portion of the specification or drawings can be found in the prior-filed application.

(2) Any amendment to an international application pursuant to this paragraph shall be effective only as to the United States, and shall have no effect on the international filing date of the application. In addition, no request to add the inadvertently omitted portion of the specification or drawings in an international application designating the United States will be acted upon by the Office prior to the entry and commencement of the national stage (§ 1.491) or the filing of an application under 35 U.S.C. 111(a) which claims benefit of the international application.

(3) If an application is not otherwise entitled to a filing date under § 1.53(b), the amendment must be by way of a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(f).

(b) Except as provided in paragraph (a) of this section, an incorporation by reference must be set forth in the specification and must:

(1) Express a clear intent to incorporate by reference by using the root words "incorporat(e)" and "reference" (e.g., "incorporate by reference"); and

(2) Clearly identify the referenced patent, application, or publication.

(c) "Essential material" may be incorporated by reference, but only by way of an incorporation by reference to a U.S. patent or U.S. patent application publication, which patent or patent application publication does not itself incorporate such essential material by reference. "Essential material" is material that is necessary to:

(1) Provide a written description of the claimed invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and set forth the best mode contemplated by the inventor of carrying out the invention as required by the first paragraph of 35 U.S.C. 112;

(2) Describe the claimed invention in terms that particularly point out and distinctly claim the invention as required by the second paragraph of 35 U.S.C. 112; or

(3) Describe the structure, material, or acts that correspond to a claimed means or step for performing a specified function as required by the sixth paragraph of 35 U.S.C. 112.

(d) Other material ("Nonessential material") may be incorporated by reference to U.S. patents, U.S. patent application publications, foreign patents, foreign published applications, prior and concurrently filed commonly owned U.S. applications, or non-patent publications. An incorporation by reference by hyperlink or other form of browser executable code is not permitted.

(e) The examiner may require the applicant to supply a copy of the material incorporated by reference. If the Office requires the applicant to supply a copy of material incorporated by reference, the material must be accompanied by a statement that the copy supplied consists of the same material incorporated by reference in the referencing application.

(f) Any insertion of material incorporated by reference into the specification or drawings of an application must be by way of an amendment to the specification or drawings. Such an amendment must be accompanied by a statement that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter.

(g) An incorporation of material by reference that does not comply with paragraphs (b), (c), or (d) of this section is not effective to incorporate such material unless corrected within any time period set by the Office, but in no case later than the close of prosecution as defined by § 1.114(b), or abandonment of the application, whichever occurs earlier. In addition:

(1) A correction to comply with paragraph (b)(1) of this section is permitted only if the application as filed clearly conveys an intent to incorporate the material by reference. A mere

56540 Federal Register / Vol. 69, No. 182 / Tuesday, September 21, 2004 / Rules and Regulations

reference to material does not convey an intent to incorporate the material by reference.

(2) A correction to comply with paragraph (b)(2) of this section is only permitted for material that was sufficiently described to uniquely identify the document.

■ 15. Section 1.58 is revised to read as follows:

§ 1.58 Chemical and mathematical formulae and tables.

(a) The specification, including the claims, may contain chemical and mathematical formulae, but shall not contain drawings or flow diagrams. The description portion of the specification may contain tables, but the same tables may only be included in both the drawings and description portion of the specification if the application was filed under 35 U.S.C. 371. Claims may contain tables either if necessary to conform to 35 U.S.C. 112 or if otherwise found to be desirable.

(b) Tables that are submitted in electronic form (§§ 1.96(c) and 1.821(c)) must maintain the spatial relationships (e.g., alignment of columns and rows) of the table elements when displayed so as to visually preserve the relational information they convey. Chemical and mathematical formulae must be encoded to maintain the proper positioning of their characters when displayed in order to preserve their intended meaning.

(c) Chemical and mathematical formulae and tables must be presented in compliance with § 1.52(a) and (b), except that chemical and mathematical formulae or tables may be placed in a landscape orientation if they cannot be presented satisfactorily in a portrait orientation. Typewritten characters used in such formulae and tables must be chosen from a block (nonscript) type font or lettering style having capital letters which should be at least 0.422 cm. (0.166 inch) high (e.g., preferably Arial, Times Roman, or Courier with a font size of 12), but may be no smaller than 0.21 cm. (0.08 inch) high (e.g., a font size of 6). A space at least 0.64 cm. (1/4 inch) high should be provided between complex formulae and tables and the text. Tables should have the lines and columns of data closely spaced to conserve space, consistent with a high degree of legibility.

■ 16. Section 1.59 is amended by revising paragraph (b) to read as follows:

§ 1.59 Expungement of information or copy of papers in application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of

this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

■ 17. Section 1.63 is amended by revising paragraph (d)(4) to read as follows:

§ 1.63 Oath or declaration.

(d) Where the power of attorney or correspondence address was changed during the prosecution of the prior application, the change in power of attorney or correspondence address must be identified in the continuation or divisional application. Otherwise, the Office may not recognize in the continuation or divisional application the change of power of attorney or correspondence address during the prosecution of the prior application.

■ 18. Section 1.69 is amended by revising paragraph (b) to read as follows:

§ 1.69 Foreign language oaths and declarations.

(b) Unless the text of any oath or declaration is in a language other than English, or in a form provided in accordance with PCT Rule 4.17(iv), it must be accompanied by an English translation together with a statement that the translation is accurate, except that in the case of an oath or declaration filed under § 1.63, the translation may be filed in the Office no later than two months from the date applicant is notified to file the translation.

■ 19. Section 1.76 is amended by revising paragraphs (a), (b)(4), (c)(2) and (d) to read as follows:

§ 1.76 Application data sheet.

(a) *Application data sheet.* An application data sheet is a sheet or sheets, that may be voluntarily submitted in either provisional or nonprovisional applications, which contains bibliographic data, arranged in a format specified by the Office. An application data sheet must be titled "Application Data Sheet" and must contain all of the section headings listed in paragraph (b) of this section, with any appropriate data for each section heading. If an application data sheet is provided, the application data sheet is part of the provisional or

nonprovisional application for which it has been submitted.

(b) * * *

(4) *Representative information.* This information includes the registration number of each practitioner having a power of attorney in the application (preferably by reference to a customer number). Providing this information in the application data sheet does not constitute a power of attorney in the application (see § 1.32).

(c) * * *

(2) Must be titled "Supplemental Application Data Sheet," include all of the section headings listed in paragraph (b) of this section, include all appropriate data for each section heading, and must identify the information that is being changed, preferably with underlining for insertions, and strike-through or brackets for text removed.

(d) *Inconsistencies between application data sheet and other documents.* For inconsistencies between information that is supplied by both an application data sheet under this section and other documents.

(1) The latest submitted information will govern notwithstanding whether supplied by an application data sheet, an amendment to the specification, a designation of a correspondence address, or by a § 1.63 or § 1.67 oath or declaration, except as provided by paragraph (d)(3) of this section;

(2) The information in the application data sheet will govern when the inconsistent information is supplied at the same time by an amendment to the specification, a designation of correspondence address, or a § 1.63 or § 1.67 oath or declaration, except as provided by paragraph (d)(3) of this section;

(3) The oath or declaration under § 1.63 or § 1.67 governs inconsistencies with the application data sheet in the naming of inventors (§ 1.41(a)(1)) and setting forth their citizenship (35 U.S.C. 115);

(4) The Office will capture bibliographic information from the application data sheet (notwithstanding whether an oath or declaration governs the information). Thus, the Office shall generally, for example, not look to an oath or declaration under § 1.63 to see if the bibliographic information contained therein is consistent with the bibliographic information captured from an application data sheet (whether the oath or declaration is submitted prior to or subsequent to the application data sheet). Captured bibliographic information derived from an application